



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Koma MORITA

Group Art Unit: 3687

Application No.: 10/670,572

Examiner: E. GORT

Filed: September 26, 2003

Docket No.: 117347

For: CHARGING SYSTEM AND CHARGING METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal and Petition for Extension of Time. Review of the August 17, 2009 Final Rejection is requested for the reasons set forth in the attached five or fewer sheets.

Should any questions arise regarding this submission, or the Review Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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Date: December 17, 2009

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REMARKS

Claims 1-4 and 6-9 are pending. Applicant respectfully requests review of the August 17, 2009 Final Rejection in view of the following remarks.

Claims 1-4, 7 and 8 stand rejected under 35 U.S.C. §103(a) over Laverty (U.S. Patent Application Publication No. 2002/0121081) in view of Friskney (U.S. Patent Application Publication No. 2004/0062205) and Best (U.S. Patent No. 4,990,018); and claims 6 and 9 stand rejected under 35 U.S.C. §103(a) over Laverty, Friskney, and Best in view of Quallen (U.S. Patent Application Publication No. 2002/0128953). The rejection is improper and should be withdrawn.

The Final Rejection commits clear error (1) by combining Best with Friskney and Laverty, and (2) by relying on the combination of Laverty, Friskney, and Best for the rejections of independent claims 1, 3 and 7.

Best is nonanalogous art. Best is directed to a photographic image holding sleeve compatible with a multiple ring binder. Laverty is directed to an online automated printing system and Friskney is directed to a system for monitoring a communications network. Similarities and differences in structure and function disclosed in the references carry great weight in determining analogy. *In re Ellis*, 476 F.2d 1370, 1372 (CCPA 1973). The differences in structure and function between Best and Laverty and Friskney are exceptional. Specifically, the structure and function of Best is to provide a protective sleeve, a sheet-like tear resistant material, for holding photograph negatives with a mounting means for mounting the sheet to a multi-ring binder. The structure and function of Laverty is to provide Internet automated printing services. The structure and function of Friskney is to monitor communications networks via a computer system. There are no similarities in either structure or function of the invention disclosed in Best and those disclosed in Laverty and Friskney.

Best is not within the Applicant's field of endeavor. The Office Action relies on Best's description of overnight services, one-hour processing, double prints, and free enlargements as allegedly teaching gathering completion status and billing based on that completion status. Best teaches a protective holder for photo negatives for use in a multi-ring binder. Best does not discuss status information and further does not discuss charging based on status information. Because Best is so dissimilar, it would not logically have commended itself to Applicant's attention in consideration of his invention as a whole. See MPEP §2141.01(a)(I). Thus, the combination of Best with Friskney and Lavery is improper.

Finally, Lavery is classified under U.S. classification 358/1.15, specifically, subject matter having details of communication between elements within a static presentation system. Friskney is classified under U.S. classification 370/252, specifically, subject matter wherein a particular communication parameter is measured. Best is classified under U.S. classification 402/79, specifically, notched or apertured sheet retainers. The classification given to Best clearly indicates that it is unrelated to Lavery and Friskney.

Accordingly, withdrawal of the rejection is respectfully requested.

Further, the combination of Lavery, Friskney, and Best would not have rendered obvious the combinations of all the features positively recited in claims 1, 3, and 7.

Specifically, the combination of the applied references would not have rendered obvious: a charging system including (1) an information generation unit for generating process information indicating contents of the executed processings and status information indicating completion status of performing the processing by the information processing device; (2) an information transmission unit for transmitting the generated process information and the generated status information to the charging apparatus; (3) an information reception unit for receiving the transmitted process information and the transmitted status information; (4) a fee calculation unit for calculating a fee for each

processing executed by the process apparatus on the basis of the received process information and the received status information; and (5) a charge amount determination unit for setting the calculated fees as a charge amount when the received status information indicates that the processings performed by the information processing device are completed normally.

The Office Action relies on Laverty as disclosing the above combination of features. Laverty discloses an Image Logic Information Database 410 (ILIAD), which provides shipping information 486 and pricing information 488 to a Vender Order System 432 (VOS). The VOS 432 "might process tasks or information, including but not limited to, job instructions, purchase orders, invoices, payments, and shipping status of orders" (see paragraph [0081]).

The Office Action fails to indicate what element of Laverty is relied upon for rendering obvious an information generation unit, but merely points to the fact that the VOS 432 is disclosed as capable of processing job instruction (alleged process information) and shipping status (alleged status information). Further, the Office Action, at page 3, describes that the VOS 432 (alleged charging system) receives the allegedly generated job instructions and shipping status via the ILIAD 410 (alleged information transmission unit). At the November 23 personal interview, Examiner Gort clarified that she believes it to be inherent that the job instructions and the shipping status are generated somewhere within Laverty and then transmitted from the ILIAD 410 to the VOS 432.

"To establish inherency, the intrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill herein. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

It is not inherent that the job instructions and shipping status are generated and transmitted through the ILIAD because Lavery does not provide any description as to how this information is created and how it gets to the VOS 432. Further, the information that the VOS 432 is explicitly described as containing does not include the job instructions or the shipping status. One skilled in the art could easily interpret the information within the VOS 432 to be preset, predetermined, or otherwise generated within that unit rather than transmitted to it. This is especially true in view of the fact that Lavery is silent as to the creation of these elements. Finally, the disclosures of Friskney and Best do not discuss job instructions, shipping status, or the generation and transmission of those elements. The mere fact that information is described in one element of Lavery does not inherently require that it is created and transmitted through another element in that reference which would be required to render the feature inherently described.

The Office Action, at page 3, describes that the shipping status of Lavery is to be construed as status information indicating completion status of performing the processing whilst again providing no support for this construction. It is not inherent that the shipping status of Lavery is status information indicating completion status of performing processing. One skilled in the art could interpret the shipping status of Lavery, to be simply an indication of whether something has or has not been shipped, as Lavery does not provide any discussion about shipping status other than to indicate that the VOS 432 may process it.

The Office Action, at page 3, relies on the VOS 432 of Lavery as disclosing an information reception unit. The Office Action fails to describe what is relied on as disclosing the reception of the job instructions (alleged process information) and the shipping status (alleged status information). At the November 23 personal interview, Examiner Gort clarified that she believes it to be inherent that the job instructions and the shipping status are received at the VOS 432 from the ILIAD 410.

It is not inherent in the disclosure of Lavery that the job instructions and the shipping status are transmitted to the VOS 432 for the reasons discussed above. The VOS 432 is only described as capable of processing job instructions and shipping status. It does not follow that this information is necessarily provided by the ILIAD 410 (alleged information transmission unit). Lavery does not provide any discussion as to the means in which the job instructions and the status information find their way to the VOS 432. One skilled in the art of charging systems could easily interpret that these items are preset within the device at the time of manufacture. Finally, the disclosures of Friskney and Best do not discuss job instructions, shipping status, or the reception thereof.

The Office Action alleges, at pages 3-4, that because the VOS might process purchase orders, invoices, and payments, it is inherent that Lavery discloses a fee calculation unit and a charge amount determination unit. The Office Action fails to describe any evidence within the disclosure of Lavery, or otherwise, that would make it clear that a fee calculation unit and a charge amount determination unit are necessary to the disclosure of Lavery. The mere fact that the VOS 432 can process invoices, purchase orders, and payments does not inherently require that it use a fee calculation unit or a charge amount determination unit. One skilled in the art would not interpret the word "process" to include calculating a fee for each processing executed by the process apparatus on the basis of the received process information and the received status information and setting the calculated fees as a charge amount when the received status information indicates that the processings are completed normally. The Office Action's construction of the VOS 432's processing greatly exceeds the bounds of reason.

Accordingly, Lavery, Friskney, and Best fail to disclose or render obvious each and every element of independent claims 1, 3 and 7. Dependent claims 2, 4, 6, 8 and 9 are also patentable at least for their dependency on any of independent claim 1, 3 and 7, as well as for the additional features they recite. Accordingly, withdrawal of the rejections is respectfully requested.